

REMARKS

I. AMENDMENT TO THE SPECIFICATION

The specification has been amended at page 6, lines 13-17 to correct an obvious error. This error was previously corrected in the parent application, U.S. Application No. 09/330,075. Prior to the amendment, the specification mistakenly recited compounds in which the conditioning agent would be insoluble. In reality, Applicants simply meant to describe the conditioning agents. By the present amendment, Applicants seek to remedy the mistake and more precisely describe the invention.

The error at page 6, lines 13-17 of the specification is apparent from the teachings of original Claim 19, which provides support for this amendment. "In establishing a disclosure, applicant may rely...on the original claims if their content justifies it." M.P.E.P. § 608.01(l). Both the error and solution are obvious to one of ordinary skill in the art because it would have been nonsensical to recite a conditioning agent that is insoluble in the compounds listed in the original specification at page 6, lines 13-17.

Further, courts have held that it is not new matter to make a correction to the specification if one skilled in the art would not only appreciate the existence of an error in the specification, but what the error is. See *In re Oda*, 170 USPQ 268, 270 (1971) (stating "when the nature of this error is known it is also known how to correct it"). Applicants submit that it would have been obvious to one skilled in the art that the language in the original specification, page 6, lines 13-17, was incompatible with the overall invention recited in Claim 19, for example. One skilled in the art would not only recognize the existence of this error, but one skilled in the art would also know how to

correct this obvious error, as Applicants have done by the above amendment. See also M.P.E.P. § 2163.07(II). Thus, Applicants submit that the amendments discussed above are supported by at least original Claim 19. Accordingly, no new matter has been added by the above amendment.

II. STATUS OF CLAIMS

Claims 1 and 3-44 are pending. Claims 20-28 are withdrawn from consideration pursuant to 35 U.S.C. § 1.142(b), as being drawn to non-elected subject matter.

Claims 1 and 38 have been amended to recite "wherein the conditioning agent is present in an amount ranging from 0.05 to 4% by weight relative to the total weight of the composition." Support for this amendment can be found on page 6, lines 8-10 of Applicants' specification. Claim 19 has been amended to recite "wherein said at least one conditioning agent is insoluble and is further chosen from...." This amendment was intended to further clarify that claim 19 is properly dependent and further limits the scope of claim 1, the claim from which it depends. Accordingly, no new matter is added by these amendments.

III. OBJECTION

Claim 19 is objected to under 37 C.F.R. § 1.75(c) as allegedly being an improper dependent claim for failing to further limit the claim from which it depends. Office Action at page 2.

Applicants have amended Claim 19 to recite "wherein said at least one conditioning agent is insoluble and is further chosen from...." This amendment further

clarifies that claim 19 is properly dependent from claim 1. Applicants therefore request the Examiner to withdraw this objection.

IV. REJECTION UNDER 35 U.S.C. § 112

Claim 19 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Office Action at page 2. The Examiner asserts that claim 19 is indefinite because it recites the limitations "conditioning agent is insoluble" and "insoluble silicones." *Id.* Applicants respectfully disagree and traverse the rejection for the following reasons.

Claim 19 has been amended as discussed in Section III above. In view of this amendment, Applicants submit that one skilled in the art would clearly know that the insoluble property claimed refers to insolubility in the medium in which it is used, e.g. in the composition. Because the insolubility of no other compound is discussed, a skilled artisan would easily recognize that it is the conditioning agent that is insoluble. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

V. REJECTION UNDER 35 U.S.C. § 102

Claims 1, 3-19, and 29-32 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,150,216 to Quack et al. ("Quack"). Office Action at page 4. The Examiner asserts that Quack teaches hair treatment compositions containing 0.1-10% branched water dispersible sulfo-group containing polyesters. *Id.* The Examiner further asserts that Quack teaches that the composition may contain

solvents and additives such as alcohol, water, silicone oils, waxes, fats, and quaternary ammonium compounds. *Id.* Applicants disagree and traverse the rejection for at least the following reasons.

As an initial matter, Applicants remind the Examiner that in response to the election of species requirement, Applicants elected non-volatile silicones as a conditioning agent for prosecution on the merits.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

M.P.E.P. § 2131 (emphasis added). Claim 1 has been amended to recite, "wherein the conditioning agent is present in an amount ranging from 0.05 to 4% by weight relative to the total weight of the composition." While Quack may disclose a composition comprising a branched sulfo-group containing polyester and an additive, such as silicone oil, Quack does not disclose that the silicone oil is present in the composition in an amount ranging from 0.05 to 4% by weight relative to the total weight of the composition. As a result, Quack does not teach "every element" of the presently claimed invention that was elected, as required for a § 102 rejection by M.P.E.P. § 2131. Accordingly, independent claim 1 and claims 3-19, and 29-32, which depend therefrom, are not anticipated by Quack.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

VI. REJECTION UNDER 35 U.S.C. § 103

A. Rejection of Claim 20

Claim 20 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable based on U.S. Patent No. 4,150,216 to Quack et al. ("Quack") in view of U.S. Patent No. 5,662,893 to George et al. ("George"). Office Action at page 4. The Examiner acknowledges that Quack does not teach the claimed cationic and/or amphoteric polymers as conditioning agents, and she turns to George to remedy this deficiency. *Id.* The Examiner asserts that George teaches using conditioning agents in hair formulations. *Id.* The Examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use conditioning the agents of George in the hair compositions of Quack to obtain improved combing and improved feeling (softness) of the hair after shampooing. See *id.*

As discussed in Section V above, in the response to the Restriction Requirement filed July 11, 2007, Applicants elected non-volatile silicones as a species of conditioning agent, however, in the Response, Applicants' representative inadvertently indicated that the elected species read on claim 20. This is incorrect. Claim 20 recites specific cationic and amphoteric polymers, which are used as conditioning agents. Thus, it is clear that claim 20 does not read on the elected species. Accordingly, Applicants respectfully request that the Examiner indicate that claim 20 is withdrawn from consideration and withdraw this § 103 rejection.

B. Rejection of Claims 33-40

Claims 33-40 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 4,150,216 to Quack et al. ("Quack") in view of U.S. Patent No. 5,320,836 to Singleton et al. ("Singleton"). Office Action at page 5. The Examiner acknowledges that Quack fails to disclose Applicants' claimed propellant, and uses Singleton to remedy this deficiency. *Id.* The Examiner asserts that Singleton teaches aerosol hair care compositions containing conventional propellants such as aliphatic hydrocarbons and dimethyl ether. *Id.* The Examiner asserts that Quack discloses sprayable hair compositions, therefore one of ordinary skill in the art would have been motivated to use the propellants disclosed in Singleton in the sprayable hair compositions disclosed in Quack with a reasonable expectation of success. See *id.*

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. Although the question of obviousness must be resolved on the basis of these factual determinations, the Supreme Court pointed out that there is no inconsistency between the *Graham* analysis and the idea underlying the teaching, suggestion, or motivation ("TSM") test. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. Further, in its recent published examination guidelines, the USPTO has solidified that the TSM test is a valid rationale for determining obviousness. See M.P.E.P. § 2141.

As discussed in Section V above, Quack fails to disclose or suggest a composition comprising a conditioning agent present in an amount ranging from 0.05 to 4% by weight relative to the total weight of the composition. Singleton does not remedy this deficiency in Quack. While Applicants recognize that "the 'mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness,'" Applicants submit that there is a substantial gap between Quack and Singleton and the claimed invention, and this gap is so great that it would not have been obvious to one of ordinary skill in the art to bridge this gap. See M.P.E.P. § 2141(III). Accordingly, Applicants submit that the rejection of claims 33-40 under § 103 is improper and should be withdrawn.

VII. DOUBLE PATENTING REJECTIONS

The Examiner sets forth four obviousness-type double patenting rejections:

1. Claims 1, 3-20, and 29-40 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1, 14-24, 26-27, and 29 of U.S. Patent No. 6,039,933 ("the '933 patent").

2. Claims 1, 3-20, and 29-40 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1-22 of U.S. Patent No. 6,692,730 ("the '730 patent").
3. Claims 1, 3-20, and 29-40 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1-19 of U.S. Application No. 10/320,707 ("the '707 application").
4. Claims 1, 3-20, and 29-40 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1-30 of U.S. Application No. 11/030,296 ("the '296 application").

Applicants respectfully traverse each of the foregoing rejections for at least the following reasons.

In all four obviousness-type double patenting rejections, the Examiner merely asserts that "[i]t would have been obvious to a skilled artisan that a similar composition would be useful as a cosmetic for treatment of the hair because the prior art uses similar components as claimed." Office Action at pages 7, 8, 9. None of the claims in the '933 patent, the '730 patent, the '707 application, or the '296 application are directed to a composition comprising at least one branched sulphonate polyester and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers, and cationic and amphiphilic surfactants, especially where the conditioning agent is in an amount ranging from 0.05 to 4% by weight relative to the total weight of the composition. While the compositions disclosed in the '933 patent, the '730 patent, the '707 application, and the '296 application may be "similar" to the claimed compositions, as asserted by the Examiner, similarity of two compositions is not enough to establish obviousness.

The analysis employed in an obviousness double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 determination. M.P.E.P. § 804(II)(B)(1).

Accordingly, as with a § 103 rejection, the key to supporting an obviousness-type double patenting rejection is “the clear articulation of the reason(s) why the claimed invention would have been obvious.” *Id.* at § 2141(III). As noted by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the analysis supporting an obviousness rejection should be made explicit. *Id.* An obviousness rejection cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *id.* The Examiner’s argument here is just such a conclusory statement. The argument provides no articulated reasoning as to why a person of ordinary skill in the art would modify the invention recited in the claims of the ‘933 patent, the ‘730 patent, the ‘707 application, or the ‘296 application to arrive at Applicant’s claimed composition. Accordingly, Applicants submit that the Examiner has failed to establish that claims 1, 3-20 and 29-40 are obvious based on any of the claims of the ‘933 patent, the ‘730 patent, the ‘707 application, or the ‘296 application.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw each of the foregoing rejections.

VIII. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 4, 2008

By: Jennifer Leach
Jennifer R. Leach
Reg. No. 54,257